

Remarks

I. Status of Claims

Claims 1-24, 29-67, 73-85, 161, and 162 are pending in this application. Claims 41-67 and 73-85 have been withdrawn from consideration. No claims have been amended by this response.

Applicants wish to thank the Examiner for withdrawing the rejections of claims 1-2, 5, 10, 11, 25, 27-30, 37-39, and 161 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,660,838 to Koga et al., as indicated in the Advisory Action dated September 27, 2005.

II. Rejections under 35 U.S.C. § 103(a)

To establish a *prima facie* case of obviousness, there must be some objective teaching in the prior art, coupled with the knowledge generally available to one of ordinary skill in the art at the time of the invention, that would have motivated one of ordinary skill to modify or combine reference teachings with a reasonable expectation of success in obtaining the presently claimed invention. M.P.E.P. §§ 2143.01 and 2143.02.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970).

The M.P.E.P. teaches that to determine the obviousness of a composition of matter claim, the *chemical and its properties* must be examined to determine whether the invention *as a whole*, and not some part of it, is obvious under 35 U.S.C. 103. M.P.E.P. § 2141.02; *In re Antonie*, 559 F.2d 618, 620, 195 U.S.P.Q. 6,8 (C.C.P.A. 1977).

A. Beck

The Examiner has maintained the rejection of claims 1-4, 10-40, 161, and 162 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pub. No. 2002/0031483 (“Beck”) for the reasons set forth in the Office Action of May 10, 2005. Advisory Action at 2. Applicants continue to disagree and traverse this rejection for at least the following reasons in addition to the reasons of record.

In response to Applicants arguments set forth in the Amendment filed September 12, 2005, the Examiner asserts that “Applicants [sic] arguments with respect to the teachings of Beck et al are not found persuasive because instant claims are directed to a composition.” Advisory Action at 2. The Examiner further states that “the intended use of the instant claims carry no patentable distinction since the claims are directed to a composition and not a method.” *Id.*

Applicants respectfully disagree that Beck teaches or suggests the claimed invention. Evidence of a suggestion or motivation to modify or combine must be “clear and particular.” *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). To establish a *prima facie* case of obviousness, all the claim limitations must be taught or suggested by the prior art. M.P.E.P. § 2143.03. Furthermore, the M.P.E.P. states that “[a]ll words

in a claim must be considered in judging the patentability of that claim against the prior art." M.P.E.P. § 2143.03; *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970). In composition claims, the *chemical and its properties* must be examined to determine whether the invention *as a whole*, and not some part of it, is obvious under 35 U.S.C. 103. M.P.E.P. § 2141.02; *In re Antonie*, 559 F.2d 618, 620, 195 U.S.P.Q. 6,8 (C.C.P.A. 1977).

The Examiner's disregard of the claim limitations is improper. Independent claims 1 and 161 recite "wherein said at least one film forming agent and said at least one compound are present in an amount effective to impart a durable non-permanent shape to said at least one keratinous fiber or to durably retain a non-permanent shape of said at least one keratinous fiber." Thus, the claims clearly recite limitations which define the composition and should not be ignored.

Beck neither teaches nor suggests a composition comprising at least one film forming agent or at least one compound chosen from C₃ to C₅ monosaccharides present in an amount to achieve the desired non-permanent shaping effect. In fact, Beck is silent as to the ability of the composition to impart a durable non-permanent shape or to durably retain a non-permanent shape of at least one keratinous fiber. Thus, how can it be obvious to choose the amounts? The Examiner, moreover, has proffered no support for why one would choose these amounts.

Furthermore, the claimed composition can only be achieved by selectively picking and choosing from isolated passages of Beck. A sugar, let alone a C₃ to C₅ monosaccharide, is not even required. Beck at par. [0004]. Even when a sugar is used, Beck discloses that glucose, a C₆ monosaccharide, is the preferred compound.

Beck at par. [0017]. Beck is silent as to the desirability of C₃ to C₅ monosaccharides. Finally, there is no suggestion in Beck that these polymeric cationic compounds must be a film forming agent, much less that the composition comprises a film forming agent and at least one compound chosen from C₃-C₅ monosaccharides.

In summary, to arrive at the claimed invention from Beck, which requires a sugar or carbohydrate that provides an energy source in the respiration of a hair follicle, one of ordinary skill in the art must choose components from a myriad of possibilities and then choose the adequate amounts without specific guidance to arrive at the claimed invention. Thus, Applicants respectfully submit that Beck's lack of specific guidance does not comply with the "clear and particular" standard articulated in *Dembiczak*. See also *In re Lee*, 277 F.3d 1338, 1343 (Fed. Cir. 2002). ("The need for specificity pervades this authority").

Applicants respectfully submit that a *prima facie* case of obviousness has not been established. Accordingly, Applicants respectfully request withdrawal of this rejection.

B. Wisotzki

The Examiner has maintained the rejection of claims 1, 2, 5, 6, 10-16, 24-40, 161, and 162 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,900,545 ("Wisotzki") for the reasons set forth in the Office Action dated May 10, 2005. Advisory Action at 2. Applicants continue to disagree and traverse this rejection for at least the following reasons in addition to the reasons of record.

The Examiner asserts that “the intended use of the instant claims carry no patentable distinction since the claims are directed to a composition and not a method.” Advisory Action at 2.

Applicants respectfully disagree with the Examiner’s position that the intended use carries no patentable weight because, as explained above, the intended use recited in the claims imparts a defined limitation on the amount of each of the components, and this amount is defined as the effective amount to impart a non-permanent shaping effect on at least one keratinous fiber. The Examiner has failed to provide any support showing that the components in the composition of Wisotzki are present in these amounts. Furthermore, as previously set forth in Applicants’ Response to the Office Action dated May 10, 2005, Wisotzki teaches away from a composition having this ability. See Response to Office Action at 18-19. Thus, how is it obvious to use a composition comprising components in these amounts?

Wisotzki is silent with respect to a composition containing a film forming agent and a compound chosen from C₃ to C₅ monosaccharides in an amount capable of providing a durable non-permanent shaping effect. Wisotzki teaches a hair split-end regenerating composition that can be added to a carrier including a hair setting preparation, such as a pomade, setting gel, or mousse. Wisotzki. at col. 3, lines 13-27 and col. 6, lines 20-23. It is the preparation which provides hair setting functionality. *Id.* Thus, the mono- or disaccharide in the hair split-end regenerating composition, is not present in an amount effective to impart a durable non-permanent shape to a keratinous fiber or to durably retain a non-permanent shape of a keratinous fiber as recited in the

present claims because the hair split-end regeneration composition must be added to the carrier to create a hair setting preparation.

Furthermore, Wisotzki teaches that the composition is a rinsable hair treatment preparation, which may be removed from the hair by rinsing with water. *Id.* at col. 6, lines 23-27. The present specification defines “durable retention of shape” as “following at least six shampoos after treatment, treated hair still retains the ability to retain a particular shape after styling as compared to the ability of untreated hair to retain a particular shape after styling.” See Specification at 6. Because the composition of Wisotzki is removable with water, the composition of Wisotzki is clearly incapable of achieving the claimed non-permanent shaping effect.

Furthermore, Wisotzki teaches that “any mono- or disaccharides” may be used in the composition. As explained above, evidence of a suggestion or motivation to modify or combine must be “clear and particular.” *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). The broad disclosure of Wisotzki that any mono- or disaccharide may be used is not the specific guidance required by U.S. patent law because there is nothing within the disclosure of Wisotzki to motivate one skilled in the art to select a C₃ to C₅ monosaccharide as recited in the present claims.

Thus, Wisotzki does not teach or suggest a composition comprising at least one film forming agent and at least one compound chosen from C₃ to C₅ monosaccharides which are present in an amount effective to impart a durable non-permanent shape to a keratinous fiber or to durably retain a non-permanent shape of a keratinous fiber as recited in the present claims. Because all of the elements recited in the present claims

are not taught or suggested by the prior art, a *prima facie* case of obviousness has not been established.

Therefore, the rejection of the present claims as obvious over Wisotzki is improper and Applicants respectfully request the withdrawal of this rejection.

C. Keil and Wisotzki

The Examiner has maintained the rejection of claims 1, 2, 5-16, 24-40, 161, and 162 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,690,924 ("Keil") in view of U.S. Patent No. 4,900,545 ("Wisotzki") for the reasons set forth in the Office Action dated May 10, 2005. Advisory Action at 2. Applicants continue to disagree and traverse this rejection for at least the following reasons.

The Examiner states that Keil teaches hair treatment compositions but acknowledges that Keil "does not teach the instant monosaccharides." Office Action dated May 10, 2005, at page 6. Thus, the Examiner relies on Wisotzki for teaching trioses, tetroses, and pentoses and film-forming cationic polymers. *Id.*

The Examiner further asserts that "the intended use of the instant claims carry no patentable distinction since the claims are directed to a composition and not a method." Advisory Action at 2.

Applicants respectfully disagree that the references can be combined in the manner suggested by the Examiner. Keil describes the benefits of a chitosan-containing composition for use as a hair fixative. Keil at col. 1, line 56 to col. 2, line 7. Keil accentuates the importance of chitosan by noting that care properties of the composition were improved over compositions "without the simultaneous presence of

the high molecular weight chitosonium-pyrrolidone carboxylate." *Id.* at col. 2, lines 1-7. Furthermore, Keil discloses the use of saccharides as a possible film-forming polymer. *Id.* at col. 2, line 52 to col. 3, line 7.

Wisotzki discloses a composition for fixing split ends that is rinsable. Wisotzki at col. 1, lines 2-48. Wisotzki also discloses a composition comprising panthenol and any mono- or disaccharide, as well as an optional ingredient, polyvinyl pyrrolidone, which is a film-forming compound. *Id.* at col. 2, lines 32-63.

Thus, one of ordinary skill in the art appreciating the benefits of chitosan advocated by Keil would not find it obvious to replace the chitosan with the sugars of Wisotzki. Moreover, by specifically teaching the use of chitosan, Keil teaches away from Wisotzki's composition.

Moreover, the compositions of Keil and Wisotzki are designed for two completely different purposes. The composition of Wisotzki is designed to fix split ends and is a rinsable composition, whereas Keil's composition is a hair fixative, which remains on the hair. There is nothing within the disclosures of Keil or Wisotzki that would motivate one skilled in the art to add the mono- or disaccharides of Wisotzki in the composition of Keil, let alone to specifically add C₃ to C₅ monosaccharide, because there is no guidance in the prior art to make such a combination.

Finally, Keil already discloses the use of a saccharide in the composition as the film-forming compound. Thus, it would not have been obvious to one skilled in the art to have added a sugar to the composition of Keil unless the sugar is *replacing* the film-forming compound of Keil. Even if such a substitution were obvious from the teachings

of Keil and Wisotzki, the resulting composition would not have all of limitations recited in the present claims.

Because there is no suggestion to combine the references, Applicants respectfully submit that a *prima facie* case of obviousness has not been established. Accordingly, Applicants respectfully request withdrawal of this rejection.

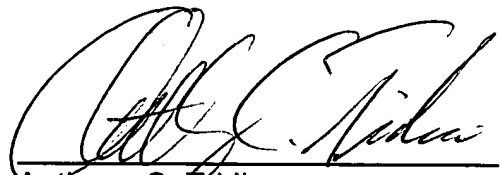
III. Conclusion

Applicants respectfully request the reconsideration and the timely allowance of the pending claims. Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

By:



Anthony C. Tridico
Reg. No. 45,958

Dated: November 3, 2005